

REMARKS

Claims 1-7 are currently pending. Claims 1 and 6 have been amended.

I. The Restriction Requirement

Please see the traversal in the Amendment filed February 18, 2009.

II. The Objection to Claim 1

Claim 1 is objected to because of the following informalities:

The Examiner requests that the comma between “500” and “ppm” be canceled from claim 1. Claim 1 was amended for clarity on February 18, 2009.

III. The Rejection under 35 U.S.C. 112

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite.

The Examiner states that the term “type” in the language “film type filter” is unclear.

To advance prosecution, Applicants have amended claims 1 and 6 to delete the term “type”. It is respectfully submitted that Applicants’ claims are clear and definite and it is requested that the rejection under 35 U.S.C. §112 be reconsidered and withdrawn.

IV. The Art Rejections

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pasqualoni et al. (671).

Claim 4 is rejected under 35 U.S.C. 103(a) as allegedly being obvious over Pasqualoni et al. (671).

Claims 1-5 are rejected under 35 U.S.C. 102(a) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Uchino et al. (206).

Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kido et al. (836).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as allegedly being obvious over Kido et al. (836).

Claims 1-2, 4 and 5 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshida et al. (118).

Claim 3 is rejected under 35 U.S.C. 103(a) as allegedly being obvious over Yoshida et al. (118).

Applicants are claiming a polishing slurry containing cerium oxide particles having a diameter of at least 3 μm is not more than 500 ppm, calculated based on the weight of particles obtained by filtering with a film type filter for analysis on which hole diameters of 3 μm are formed and the weight of all the solids in the polishing slurry.

The Examiner's position appears to be that the cited art teaches low diameter particles, which the Examiner states inherently have Applicants' claimed particle size characteristics. While the references may use a different measurement method, the Examiner's position is that Applicants are still claiming particles and that Applicants have not established that the particles of the cited art, if measured by the claimed method step, do not have Applicants' claimed particle characteristics.

Applicants respectfully submit that the present invention is not anticipated by or obvious over the disclosures of over Pasqualoni et al. (671), Uchino et al. (206), Kido et al. (836) and

Yoshida et al. (118) and request that the Examiner reconsider and withdraw this rejection in view of the following remarks.

As set forth in the Amendment filed May 15, 2008, the measuring methods of particle size of the Cited references are all different from that of the present application. Further to the rejections based on Uchino et al. (206), Kido et al. (836), Yoshida et al. (118) the particle size of the three cited references are measured by a laser diffraction type particle size distribution meter. But said distribution meter cannot detect small contents of particles (on the order of about 0.X % (X x 1000 ppm)) because diffraction of such few particles is so weak that it is not easy for the measured particle size and its distribution to be reflected.

To demonstrate that the particle size distribution measurement methods of the cited art are not an indication of the presence of the claimed particle size distributions, Applicants have conducted testing on the polishing slurry described in Yoshida et al (118), which the Examiner states has no coarse particles as in the present invention. As set forth in further detail in the attached 132 Declaration, the when the slurry in the Yoshida reference is observed by the method described in the specification and claims of the present application, coarse particles are present therein.

Further, Applicants have conducted comparative testing to show that the numbers of scratches by the use of the polishing slurries of the present invention were unexpectedly improved over the use of the polishing slurries of the cited art.

Further to the rejections based on Pasqualoni et al, when cerium oxide instead of silica is used as the polishing particles in Pasqualoni et al, it is difficult to prepare a polishing slurry

satisfying Pasqualoni et al's claim. That is, cerium oxide and silica are not readily interchangeable in Pasqualoni et al. As set forth in further detail in the attached 132 Declaration, the disclosures of Pasqualoni et al (671) cannot be applied to any polishing slurry where cerium oxide (ceria) particles are used as polishing particles as in the present invention. And by the use of the polishing slurry using cerium oxide particles as abrasive particles as in the present invention, unexpected improvements in the polish speed consistent with the prevention of polish scratches are achieved.

For the above reasons, it is respectfully submitted that the subject matter of claims 1-7 is neither taught by nor made obvious from the disclosures of Pasqualoni et al. (671), Uchino et al. (206), Kido et al. (836) and Yoshida et al. (118) and it is requested that the rejections under 35 U.S.C. §§102 and 103 be reconsidered and withdrawn.

V. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the objection to the claims, rejection under 35 U.S.C. §112 and the art rejections under 35 U.S.C. §§102 and 103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

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Attorney Docket No.: 062110

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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